REMARKS

Claims 1-20 were originally filed in the present application.

Claims 1-20 are pending in the present application.

Claims 1, 2, 9, 10 and 17 were rejected in the June 26, 2007 Office Action.

Claims 3-8, 11-16 and 18-20 were objected to in the June 26, 2007 Office Action.

No claims have been allowed.

Claims 1, 4, 9, 12, 17 and 19 are amended herein.

Claims 2, 3, 10, 11 and 18 are cancelled herein.

Claims 1, 4-9, 12-17, 19 and 20 remain in the present application.

Reconsideration of the claims is respectfully requested.

In Section 3 of the June 26, 2007 Office Action, the Examiner objected to Claims 1, 3, 6, 7, 9, 14, 15 and 17 because the claims contain the phrase "capable of". Applicants respectfully disagree and traverse this objection.

The Examiner justify, for example, ignoring all "capable of" limitations by misapplying the decision in *In re Hutchison*, 154 F.2d 135 (CCPA 1946). In *Hutchinson*, the court did not consider the preamble phrase "adapted for use in the fabrication of a metal template or the like" to "constitute a limitation in any patentable sense." In contrast, the "capable of" limitation in the present application imposes a capability requirement on, for example, the *PMD module* required by Claim 1 – i.e., the *PMD module must be able to transmit data packets to and receive data packets from selected ones of said N interfacing peripheral devices*. The Examiner is invited to consider the non-

precedential BPAI decision in *Ex parte Prall*, Appeal No. 2003-1556, which may be found at www.uspto.gov/web/offices/dcom/bpai/decisions/fd031556.pdf. While the limitation at issue in *Hutchinson* was in the preamble and merely recited an intended use, the limitation at issue in *Prall* imposed a capability requirement on the respective claim element – like that in the current application.

Moreover, the determination of whether clauses such as "capable of" (or "adapted to/for," or "wherein/whereby") are limitations in a claim are not subject to a *per se* rule, but instead depends on the specific facts of the case. MPEP §2111.04, p. 2100-46 (8th ed., rev. 5, August 2006)(citing *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329 (Fed. Cir. 2005)). When such a clause states a condition that is material to patentability, the clause cannot be ignored in order to change the substance of the invention. *Id.*

Accordingly, Applicants respectfully request that the objection to Claims 1, 3, 6, 7, 9, 14, 15 and 17 be withdrawn.

In Sections 4-6 of the June 26, 2007 Office Action, the Examiner rejected Claims 1, 2, 9, 10 and 17 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,078,963 to *Civanlar, et al.*, (the "Civanlar reference") in view of U.S. Patent Application Publication No. 2004/001478 to *Wong* (the "Wong reference"). Applicants respectfully disagree and traverse the Examiner's arguments in support of this rejection.

Claim 1 of the present application currently requires:

> A router for interconnecting N interfacing peripheral devices, said router comprising a plurality of routing nodes coupled to one another via switching circuitry, a first one of said plurality of routing nodes comprising:

at least one physical medium device (PMD) module capable of transmitting data packets to and receiving data packets from selected ones of said N interfacing peripheral devices;

an ingress processor capable of receiving incoming data packets from said at least one PMD module;

an egress processor capable of transmitting data packets to said at least one PMD module; and

a medium access control (MAC) processor capable of forwarding data packets from said ingress processor to said switching circuitry and forwarding data packets from said switching circuitry to said egress processor, wherein said MAC processor is capable of determining whether a first data packet received from said ingress processor is directed to said egress processor and, in response to said determination, transferring said first data packet directly to said egress processor without forwarding said first data packet through said switching circuitry,

wherein said MAC processor determines that said first data packet is directed to said egress processor if said address of said first data packet matches an address of said MAC processor. (emphasis added).

Notably, Claim 1 requires a MAC processor capable of forwarding data packets from said ingress process to said switching circuitry and *forwarding data packets from said switching circuitry to said egress processor.* In addition, Claim 1 requires that the *MAC processor determine that said first data packet is directed to said egress processor if said address of said first data packet matches an address of said MAC processor.*

As the Examiner appears to suggest in Sections 8 and 9 of June 26, 2007 Office Action, the Civanlar reference, either alone or in any combination with the Wong reference, fails to teach or disclose, for example, a *MAC processor that determines that said first data packet is directed to said egress processor if said address of said first data packet matches an address of said MAC processor,* as required by Claim 1 and its dependent, Claim 2. Similar arguments hold true for Claim 9 and its dependent, Claim 10. Likewise, similar arguments hold true for Claim 17.

Moreover, there is no suggestion or motivation within the Civanlar reference and the Wong reference to prompt one of ordinary skill to selectively combine discrete elements from each and then

seek out still others as required by Claims 1, 2, 9, 10 and 17.

In Section 8 of the June 26, 2007 Office Action, the Examiner objected to Claims 3-8, 11-16 and 18-20 as being dependent upon a rejected base claim, but suggested that Claims 3-8, 11-16 and 18-20 would be allowable if it were rewritten in independent form including all the limitations of the base and intervening claims. Applicants thank the Examiner for this suggestion and have amended Claims 1, 9 and 17 to include limitations from Claims 3, 11 and 18, respectively.
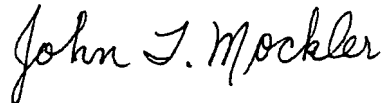
SUMMARY

For the reasons given above, the Applicants respectfully request reconsideration and allowance of the pending claims and that this application be passed to issue. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *jmockler@munckbutrus.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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